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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/625,240	07/22/2003	Opher D. Kahn	Intel 2207/670602	8612

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EXAMINER

HUISMAN, DAVID J

ART UNIT	PAPER NUMBER
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2183

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/12/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/625,240	Applicant(s) KAHN ET AL.	
	Examiner David J. Huisman	Art Unit 2183	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 October 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 23-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 23-35 is/are allowed.
- 6) ☒ Claim(s) 36-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date. _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 23-41 have been examined.

Papers Submitted

2. It is hereby acknowledged that the following papers have been received and placed of record in the file: Amendment as received on 10/24/2006.

Priority

3. It is noted that this application appears to claim subject matter disclosed in prior Application No. 09536476, now U.S. Patent No. 6,625,724, filed on March 28, 2000. A reference to the prior application must be inserted as the first sentence(s) of the specification of this application or in an application data sheet (37 CFR 1.76), if applicant intends to rely on the filing date of the prior application under 35 U.S.C. 119(e), 120, 121, or 365(c). See 37 CFR 1.78(a). For benefit claims under 35 U.S.C. 120, 121, or 365(c), the reference must include the relationship (i.e., continuation, divisional, or continuation-in-part) of all nonprovisional applications. If the application is a utility or plant application filed under 35 U.S.C. 111(a) on or after November 29, 2000, the specific reference to the prior application must be submitted during the pendency of the application and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior application. If the application is a utility or plant application which entered the national stage from an international application filed on or after November 29, 2000, after compliance with 35 U.S.C. 371, the specific reference must be submitted during the pendency of the application and within the later of four months

Art Unit: 2183

from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) or sixteen months from the filing date of the prior application. See 37 CFR 1.78(a)(2)(ii) and (a)(5)(ii).

This time period is not extendable and a failure to submit the reference required by 35 U.S.C.

119(e) and/or 120, where applicable, within this time period is considered a waiver of any

benefit of such prior application(s) under 35 U.S.C. 119(e), 120, 121 and 365(c). A benefit claim

filed after the required time period may be accepted if it is accompanied by a grantable petition

to accept an unintentionally delayed benefit claim under 35 U.S.C. 119(e), 120, 121 and 365(c).

The petition must be accompanied by (1) the reference required by 35 U.S.C. 120 or 119(e) and

37 CFR 1.78(a)(2) or (a)(5) to the prior application (unless previously submitted), (2) a surcharge

under 37 CFR 1.17(t), and (3) a statement that the entire delay between the date the claim was

due under 37 CFR 1.78(a)(2) or (a)(5) and the date the claim was filed was unintentional. The

Director may require additional information where there is a question whether the delay was

unintentional. The petition should be addressed to: Mail Stop Petition, Commissioner for

Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

If the reference to the prior application was previously submitted within the time period

set forth in 37 CFR 1.78(a), but not in the first sentence(s) of the specification or an application

data sheet (ADS) as required by 37 CFR 1.78(a) (e.g., if the reference was submitted in an oath

or declaration or the application transmittal letter), and the information concerning the benefit

claim was recognized by the Office as shown by its inclusion on the first filing receipt, the

petition under 37 CFR 1.78(a) and the surcharge under 37 CFR 1.17(t) are not required.

Applicant is still required to submit the reference in compliance with 37 CFR 1.78(a) by filing an

amendment to the first sentence(s) of the specification or an ADS. See MPEP § 201.11.

Art Unit: 2183

4. Applicant filed a preliminary amendment July 22, 2003, which said "Prior to examination, please amend the above-identified continuation application as follows. This application is a Continuation of U.S. Patent Application Serial No. 09/536,476." However, Applicant did not specify that the specification was to be amended nor did applicant specify which part of the specification was to be amended. Therefore, applicant has not met the above priority requirements. Further evidence of applicant's failure to meet the requirements above is the substitute specification filed on June 16, 2006, which does not have the priority statement at the beginning of the specification.

Claim Objections

5. Claim 40 is objected to because of the following informalities: In lines 5-6, replace "an 32-bit" with --a 32-bit--. Appropriate correction is required.

Withdrawn Rejections

6. Applicant stated on page 7 of the remarks filed on October 24, 2006, that the claims were amended, in accordance with the examiner's recommendation, to overcome the 35 U.S.C. 112, 2nd paragraph, rejections. The examiner notes that applicant did not amend claim 23 to overcome the indefinite rejection set forth in paragraph 7 of the Office Action mailed on September 7, 2006. However, after further consideration, the examiner has withdrawn this specific rejection applied to claim 23.

Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 36-41 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

9. Referring to claim 36, the claim does not produce a tangible result in two ways:

a) when the determining steps are satisfied, identifier decoding is performed.

However, merely decoding an identifier (i.e., determining the value of an identifier) does not produce a tangible result, and therefore, the claimed invention has no practical application.

b) when the determining steps are not satisfied, the decoding does not take place, and consequently, all that happens is determining. Determining alone does not produce a tangible result, and therefore, the claimed invention has no practical application.

The examiner recommends adding language that specifies:

a) what happens in response to said determining steps not being satisfied (i.e., a 3-bit register identifier is decoded, or some other similar language); **and**

b) that a value is outputted from a register accessed according to the decoded identifier.

10. Referring to claims 37-39, the claims do not produce a tangible result for similar reasons set forth in the rejection of claim 36. Claims 37-39 provide more details on decoding and what is decoded, but do not produce a tangible result.

11. Referring to claim 40, the claim is not directed towards an arrangement of parts but instead towards programmed functionality, which does not produce a tangible result in two ways:

a) when the determining steps are satisfied, identifier decoding is performed.

Art Unit: 2183

However, merely decoding an identifier (i.e., determining the value of an identifier) does not produce a tangible result, and therefore, the claimed invention has no practical application.

b) when the determining steps are not satisfied, the decoding does not take place, and consequently, all that happens is determining. Determining alone does not produce a tangible result, and therefore, the claimed invention has no practical application.

12. Referring to claim 41, the claim does not produce a tangible result for similar reasons set forth in the rejection of claim 40. Claim 41 provides more details on decoding, but does not produce a tangible result.

Claim Rejections - 35 USC § 112

13. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

14. Claims 36-41 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

15. Referring to claim 36 and, specifically, the phrase “in response to said determining steps being satisfied,” it is not clear how the determining steps are satisfied. That is, the claim includes multiple determining steps that determine whether a particular field contains a certain value. However, is each determining step satisfied when that field holds the appropriate value or when it does not hold the value? Applicant should clarify the claim. For purposes of examination, the examiner’s interpretation is that the determining steps are satisfied when the fields do in fact hold the appropriate values.

Art Unit: 2183

16. Claims 37-39 are rejected under 35 U.S.C. 112, 2nd paragraph, as being indefinite, because they are dependent, either directly or indirectly, on an indefinite claim.

17. Referring to claim 40:

- With respect to the phrase “in response to said determining steps being satisfied,” it is not clear how the determining steps are satisfied. That is, the claim includes comparators to determine whether a particular field contains a certain value. However, is each determining step satisfied when that field holds the appropriate value or when it does not hold the value? Applicant should clarify the claim.
- While the preamble seems to suggest applicant is trying to claim a processor, the body of the claim makes it unclear as to whether applicant is trying to claim a processor or a method. The last paragraph of the claim includes the phrase “in response to said determining steps being satisfied.” Steps are found in method claims but applicant does not appear to be claiming steps. Applicant instead is claiming comparators that “determine whether...”. Applicant should find more appropriate language which eliminates the ambiguity.
- Furthermore, the limitation "said determining steps" is recited in the last paragraph. There is insufficient antecedent basis for this limitation in the claim as no determining steps were previously mentioned.
 - Due to the above problems, the examiner will interpret this limitation as “in response to the mod field containing a value selected from the values of 01B, 10B, and 00B, the r/m field containing a value of 100B, and the index field containing a value of 100B.”

Art Unit: 2183

18. Claim 41 is rejected under 35 U.S.C. 112, 2nd paragraph, as being indefinite, because it is dependent on an indefinite claim.

Allowable Subject Matter

19. Claims 23-35 are allowed.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David J. Huisman whose telephone number is (571) 272-4168. The examiner can normally be reached on Monday-Friday (8:00-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eddie Chan can be reached on (571) 272-4162. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Application/Control Number: 10/625,240

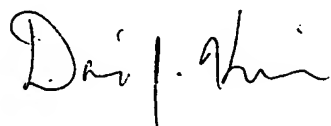
Page 9

Art Unit: 2183.

DJH

David J. Huisman

January 8, 2007

A handwritten signature in cursive script, reading "David J. Huisman". The signature is written in dark ink and is positioned below the typed name.